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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,412	02/14/2001	Danny Soroker	6727/01290	4685

7590

04/21/2006

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EXAMINER

BAYARD, DJENANE M

ART UNIT

PAPER NUMBER

2141

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,412

Applicant(s)

SOROKER ET AL.

Examiner

Djenane M. Bayard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-23, 25-34 and 36-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-23, 25-34 and 36-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to amendment received on 1/27/06 in which claims 21-23, 25-34, 36-43 are pending.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 21-23, 25-26, 29-31, 34, 36-37, 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,327,612 to Watanabe in view of Notes/Domino R5 Beta Feedback Forum to Calabria.

a. As per claim 21, 22 and 23, Wanabe teaches for processing an electronic mail (e-mail) message having an attachment, comprising: receiving as input from a sender the e-mail message and the attachment for transmission to a recipient; sending the e-mail message and the attachment to the recipient; (See col. 2). However, Wanabe fails to specifically teach receiving as input from the sender an instruction indicative of whether to save the attachment on a computer of the sender; and responsive to the instruction indicating not to save the attachment, saving, on the computer of the sender, the e-mail message without the attachment

Calabria teaches receiving as input from the sender an instruction indicative of whether to save the attachment on a computer of the sender; and responsive to the instruction indicating not to save the attachment, saving, on the computer of the sender, the e-mail message without the attachment (See *Calabria on the Notes/Domino forum clearly teaches "if the sender needs attachment saved with the sent copy of mail, they must choose a menu option". It is inherent to one with ordinary skill in the art at the time of the invention, as presented in the applicant*

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argument dated 1/27/06, that the email message without or with the attachment will be saved on the computer of the sender).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to introduce the teaching of Calabria in the claimed invention of Wanabe in order to save lots of disk space (See message content, Calabria)

b. As per claims 25, 30 and 36, Wanabe teaches receiving the instruction as the input comprises receiving the instruction as the input at a the time of writing of the e-mail message by the sender (See col. 2).

c. As per claims 26, 31 and 37, Wanabe teaches wherein receiving the instruction as the input comprises receiving the instruction as the input at a time of sending of the e-mail message by the sender (See col. 4, lines 1-67).

d. As per claims 29, 34 and 40, Wanabe in view of Calabria teaches the claimed invention as described above. However, Wanabe fails to teach receiving as input from the sender a designation of a first set of one or more recipients and a designation of a second set of one or more recipients, wherein sending the e-mail message and the attachment to the recipient comprises: sending the e-mail message and the attachment to the first set of one or more recipients; and sending the e-mail message without the attachment to the second set of one or more recipient (See col. 4, lines 1-67).

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e. As per claims 41, 42 and 43, Wanabe in view of Calabria teaches the claimed invention as described above. However, Wanabe fails to teach wherein receiving the instruction as input from the sender comprises receiving as input from the sender the instruction indicative of whether to save the attachment in a sent items folder on the computer of the sender, and wherein saving the e-mail message without the attachment comprises saving, in the sent items folder on the computer of the sender, the e-mail message without the attachment

Calabria teaches wherein receiving the instruction as input from the sender comprises receiving as input from the sender the instruction indicative of whether to save the attachment in a sent items folder on the computer of the sender, and wherein saving the e-mail message without the attachment comprises saving, in the sent items folder on the computer of the sender, the e-mail message without the attachment (*See Calabria on the Notes/Domino forum clearly teaches "if the sender needs attachment saved with the sent copy of mail, they must choose a menu option). It is inherent to one with ordinary skill in the art at the time of the invention, as presented in the applicant argument dated 1/27/06, that the email message without or with the attachment will be saved on the computer of the sender).*

It would have been obvious to one with ordinary skill in the art at the time the invention was made to introduce the teaching of Calabria in the claimed invention of Wanabe in order to save lots of disk space (See message content, Calabria)

5. Claims 27-28, 32-33 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,327,612 to Watanabe in view of Notes/Domino R5 Beta Feedback Forum

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to Calabria as applied to claims 21, 22 and 23 above, and further in view of U.S. Patent Application No. 6,256672 to Redpath.

a. As per claim 27, 32 and 38, Wanabe in view of Calabria teaches the claimed invention as described above. However, Wanabe fails to teach wherein saving the e-mail message without the attachment comprises saving, with the e-mail message, information identifying the attachment.

Redpath teaches wherein saving the e-mail message without the attachment comprises saving, with the e-mail message, information identifying the attachment (See col. 3, lines 31-54).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein saving the e-mail message without the attachment comprises saving, with the e-mail message, information identifying the attachment as taught by Redpath in the claimed invention of Wanabe in view of Calabria in order to provide the advantage of allowing a use to send underlying attachment data to only those needing the data while still allowing others to be informed of what has been sent (See col. 3, lines 31-54).

b. As per claims 28, 33 and 39, Wanabe in view of Calabria teaches the claimed invention as described above. However, Wanabe fails to teach wherein saving the e-mail message without the attachment comprises saving a name of the attachment with the e-mail message.

Redpath teaches wherein saving the e-mail message without the attachment comprises saving a name of the attachment with the e-mail message (See col. 3, lines 31-54).

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It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein saving the e-mail message without the attachment comprises saving a name of the attachment with the e-mail message as taught by Redpath in the claimed invention of Wanabe in view of Calabria in order to provide the advantage of allowing a use to send underlying attachment data to only those needing the data while still allowing others to be informed of what has been sent (See col. 3, lines 31-54).


Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M. Bayard whose telephone number is (571) 272-3878. The examiner can normally be reached on Monday- Friday 5:30 AM- 3:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Djenane Bayard


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER